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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,357

09/10/2003

Menashe Bar-Eli

ABGENIX 030C1

7855

20995 7590 04/06/2005

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EXAMINER

BLANCHARD, DAVID J

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/660,357

Applicant(s)

BAR-ELI ET AL.

Examiner

David J. Blanchard

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1, 3, 6-8, 10, 14-15 and 19 have been amended.  
Claims 20-27 have been added.  
Claims 1-27 are pending and under examination.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Objections/Rejections Withdrawn***

3. The objection to the specification for containing grammatical informalities is withdrawn in view of the amendment to the specification.
4. The objection to claims 1 and 10 for missing a comma after the "5" and a space before the "5" is withdrawn in view of the amendments to the claims.
5. The rejections of claims 1-19, parts a-e, under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention are withdrawn in view of the amendments to the claims.
6. The rejection of claims 1-6, 8-9 and 15-19 under 35 U.S.C. 112 first paragraph, enablement is withdrawn in view of applicant's arguments and amendments to the claims.

***Response to Arguments***

7. The rejection of claims 1-19 and applied to newly added claims 20-27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 and newly added claim 18-21 of copending Application no. 10/330,530 is maintained.

The response filed 2/22/2005 has been carefully considered, but is deemed not to be persuasive. The response argues that the claims in the instant application are drawn to methods of inhibiting tumor growth, inhibiting cell invasion or increasing survival of *an animal* and these methods comprise the step of "selecting an animal", which is not found in the claims of co-pending application no. 10/330,530. Applicant argues that in contrast, the claims of co-pending application 10/330,530 are drawn to methods of inhibiting cell proliferation associated with the expression of the MUC18 tumor antigen by contacting cells expressing MUC18 with a monoclonal antibody that binds MUC18 and incubating these cells in the presence of the antibody and these claims include the step of "incubating said cells and said antibody" which is not found in the instant application. In response to these arguments, the claims in co-pending application no. 10/330,530 encompass contacting cells expressing MUC18 in vivo, i.e., in an animal, and it would have been obvious to select an animal containing cells that are expressing MUC18 since the treatment is the administration of a MUC18 antibody. Further, the instant claims and the claims in co-pending application no. 10/330,530 are drawn to methods of inhibiting tumor cell proliferation associated with the expression of MUC18, wherein the tumor is melanoma or is tumor metastasis and it would have been

obvious that inhibition of tumor cells expressing MUC18 comprising administering a MUC18 antibody would increase the survival of an animal suffering from a tumor expressing MUC18.

Therefore, the rejection of claims 1-27 under the judicially created doctrine of obviousness-type double patenting is maintained.

Applicant is reminded of the following:

Claims 1-27 are directed to an invention not patentably distinct from claims 1-21 of commonly assigned Application No. 10/330,530. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned Application No. 10/330,530, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

***Conclusion***

8. No claim is allowed.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (571) 272-0827. The examiner can normally be reached at Monday through Friday from 8:00 AM to 6:00 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787. The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,  
David J. Blanchard  
571-272-0827



LARRY R. HELMS, PH.D  
PRIMARY EXAMINER